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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,568	01/21/2004	Greg Birchmeier	14252	3441
7590		09/06/2007		
Sally J Brown				
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		EXAMINER		
		LUONG, VINH		
		ART UNIT		PAPER NUMBER
		3682		
		MAIL DATE		DELIVERY MODE
		09/06/2007		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/761,568

Applicant(s)

BIRCHMEIER ET AL.

Examiner

Vinh T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 7, 9, 11, 12, 14-16, 18, 21, 22, 24-26, 29, 31-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 9, 11, 12, 14-16, 18, 21, 22, 24-26, 29, 31-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

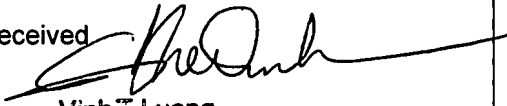
## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received

  
Vinh T. Luong  
Primary Examiner

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 25, 2007 has been entered.
2. The drawings were received on July 25, 2007. These drawings are accepted by the Examiner.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-3, 6, 7, 9, 11, 12, 14-16, 18, 21, 22, 24-26, 29, and 31-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "sealable" in Claims 1, 15, 26, 32, 33, and 39 is vague and indefinite in the sense that things which may be done are not required to be done. For example, in Claim 1, the hole is sealable, but it is not structurally required to be sealed. See "discardable" in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), "crimpable" in *Application of Collier*, 158 USPQ 266 (CCPA 1968), "removable" in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and "comparable" in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

Claims 9, 18, 29, and 37 recite "the solid mass is different from the particles." However, the particles inherently have a mass. Thus, the particles can be the same as the solid mass. It is

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unclear as to what differences between/among the solid mass and the particles claimed in the claims.

5. Claims 1-3, 6, 7, 11, 14, 26, 31-36, 38, and 39, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Tetsuo et al. (JP 61-222868).

Regarding Claim 1, Tetsuo teaches a steering wheel for a vehicle, comprising:

a central member 2 attached to a steering column (not shown);

an outer rim 3 connected to the central member 2 and having a continuous, internal chamber 3, wherein the outer rim 3 generally encircles the central member 2; and

a fluid 7 disposed within the internal chamber 3, wherein the fluid 7 dampens vibration during steering wheel use, and wherein particles 6 are disposed within the fluid 7, wherein the outer rim 3 comprises a sealable hole 5d (FIG. 3) for inserting the fluid 7 into the chamber 3, wherein the sealable hole 5d allows adjustment of the type or volume of the fluid 7 over the life of vehicle and the fluid 7 is selected from a group of liquid of high viscosity. See page 4 of translation attached.

Note that the fluid 7 is capable of occupying less than three quarters of the entire volume of the chamber 3 as seen in FIG. 4. In addition, Tetsuo's high viscosity liquid inherently includes oil, grease, antifreeze, and a combination thereof as evidenced by publication *SynLube Lube-4-Life* cited. Therefore, Applicant's Claim 1 is anticipated by Tetsuo because Tetsuo explicitly or implicitly teaches each claimed element. *Ex parte Smith*, 83 USPQ2d 1509 (B.P.A.I. 2007).

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Regarding Claim 2, Tetsuo's chamber 3 is continuous such that the fluid 7 flows in both clockwise and counterclockwise directions from each point within the chamber 3 as seen, e.g., in FIGS. 2 and 6.

Regarding Claims 3, 6, 7, and 11, the fluid 7 has a volume, a viscosity, or a weight selected to dampen vibrations of the outer rim 3 caused by operation of the vehicle or to provide a predetermined inertia for the outer rim 3. See pages 3-5 of translation.

Regarding Claim 14, see a removable plug 5 sized to be seated in the hole 5d.

Regarding Claims 26, 31, and 39, see regarding Claims 1, 3, 6, and 7 above. Moreover, it is well settled that the "whereby" or "wherein" clause that merely states the inherent result of the limitations set forth in the claim (e.g., "wherein the sealable hole allows adjustment of the type or volume of the fluid over the life of the vehicle") adds nothing to the patentability or substance of the claim. *Texas Instrument Inc. v. International Trade Commission*, 26 USPQ2d 1018 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); and *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

Regarding claim 32, Tetsuo teaches a steering wheel for a vehicle, comprising: central member means 2 for attachment to a steering column of a vehicle; outer rim means 3 for connection to the central member means 2, the outer rim means 3 having an internal chamber 3, wherein the outer rim means 3 generally encircles the central member means 2; a damping means 7 disposed within the internal chamber 3 for damping vibrations of the outer rim 3 caused by operation of the vehicle, wherein the damping means comprises a fluid 7 that is capable of occupying less than an entire volume of the internal chamber 3, and wherein particles 6 are disposed within the damping means 7, wherein the outer rim 3 comprises a sealable hole 5d

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(FIG. 3) for inserting the fluid 7 into the chamber 3, wherein the sealable hole 5d allows adjustment of the type or volume of the fluid 7 over the life of vehicle and the fluid 7 is selected from a group of liquid of high viscosity. See page 4 of translation attached.

Note that the fluid 7 is capable of occupying less than three quarters of the entire volume of the chamber 3 as seen in FIG. 4. In addition, Tetsuo's liquid of high viscosity inherently includes oil, grease, antifreeze, and a combination thereof. See cited publications. Therefore, Applicant's Claim 32 is anticipated by Tetsuo because Tetsuo explicitly or implicitly teaches each claimed element. *Ex parte Smith, supra*.

Regarding Claims 33 and 35, see regarding Claims 1 and 14 above.

Regarding Claims 34, 36, and 38, see regarding Claims 2, 3, 6, and 7 above.

6. Claims 9, 12, 15, 16, 18, 21, 22, 24, 25, 29, and 37, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetsuo.

Regarding Claims 9, 12, 15, 16, 18, 21, 22, 24, 25, 29, and 37, Tetsuo teaches the invention substantially as claimed. In addition, Tetsuo teaches at least one solid mass, such as, e.g., 12 (FIGS. 6 and 7), 15 (FIGS. 8 and 9), and 17 (FIG. 10). The instant solid mass is different from the particles 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine at least one solid mass in the steering wheel of Tetsuo in order to dampen the vibration as taught or suggested by Tetsuo. The results of the combination are predictable. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007); *Ex parte Smith*, 83 USPQ2d 1509 (B.P.A.I. 2007); *Ex parte Catan*, B.P.A.I., No. 2007-0820, 7/3/07; and *Ex parte Kubin*, 83 USPQ2d 1410 (B.P.A.I. 2007).

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7. Claims 1-3, 6, 7, 9, 11, 12, 14-16, 18, 21, 22, 24-26, 29, and 31-39, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetsuo in view of Kreuzer'383 (DE 3927383 A1).

Regarding Claims 1-3, 6, 7, 11, 14, 26, 31-36, 38, and 39, Tetsuo teaches the invention substantially as claimed. However, Tetsuo does not explicitly teach the fluid being selected from the group consisting of water, oil, grease, antifreeze, and a combination thereof.

Kreuzer'383 teaches the well-known liquid, such as, oil and water or a mixture of glycol and water (antifreeze) in order to dampen the vibration of the steering wheel. See *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the fluid from the group consisting of water, oil, grease, antifreeze, and a combination thereof in order to dampen the vibration of Tetsuo's steering wheel as taught or suggest by Kreuzer'383. The results of the combination are predictable. *KSR International Co. v. Teleflex Inc.*; *Ex parte Smith*; *Ex parte Catan*; and *Ex parte Kubin, supra*.

Regarding Claims 9, 12, 15, 16, 18, 21, 22, 24, 25, 29, and 37, Tetsuo teaches the invention substantially as claimed. In addition, Tetsuo teaches at least one solid mass, such as, e.g., 12 (FIGS. 6 and 7), 15 (FIGS. 8 and 9), and 17 (FIG. 10). The instant solid mass is different from the particles 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form at least one solid mass in the steering wheel of Tetsuo with the viscous liquid of Kreuzer'383 in order to dampen the vibration as taught or suggested by Tetsuo.

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*KSR International Co. v. Teleflex Inc.*; *Ex parte Smith*; *Ex parte Catan*; and *Ex parte Kubin*, *supra*.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: SynLube Lube-4-Life (high viscosity fluid on page 6).

9. Applicant's arguments filed July 25, 2007 have been fully considered but they are not persuasive.

#### **I. Drawings**

The objection to the drawings is withdrawn in view of replacement drawings.

#### **II. 35 USC 112**

Applicant stated that Claims 9, 18, and 29 have been amended to clarify that the solid mass is different from the particles.

As noted, the pending claims must be given their broadest reasonable interpretation consistent with the specification, however, it is impermissible to import the subject matter from the specification into the claims. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1320 (Fed. Cir. 2005) *en banc* and MPEP 2111. In the instant case, each of the particles inherently has a mass, thus, each particle inherently can be a solid mass.

The Court in *In re Zletz*, 13 USPQ2d 1320, 1322 (CAFC 1989) emphasized "An essential purpose of patent examination is to fashion claims that are *precise, clear, correct, and unambiguous*. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."

In the instant case, the terms "particles" and "at least one solid mass" can not be construed as being different in a precise, clear, correct, and unambiguous manner. See double



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inclusion in MPEP 2173.05(o). Therefore, the Examiner respectfully submits that the claims remain to be vague and indefinite.

### III. Art rejection

The previous art rejections are withdrawn in view of Applicant's amendments. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Particularly, with respect to Tetsuo, Applicant contended that Tetsuo does not teach the fluid being selected from a group consisting of water, oil, grease, antifreeze, and a combination thereof. The Examiner respectfully submits that Tetsuo teaches high viscosity fluid as seen in the translation. In addition, common knowledge based on standard material science textbooks or literature teaches that the high viscosity fluid inherently include oil, grease, etc. Therefore, Tetsuo inherently or implicitly teaches the fluid being selected from a group consisting of water, oil, grease, antifreeze, and a combination thereof.

Assuming *arguendo* that Tetsuo does not teach the fluid being selected from a group consisting of water, oil, grease, antifreeze, and a combination thereof, however, water, oil, grease, antifreeze, and a combination thereof are notoriously well known damping fluid as evidenced by the art cited. See for examples, the oil in GB 433,531 cited by Applicant, and the oil and water or a mixture of glycol and water (antifreeze) in DE 3927383 A1.

It is well settled that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

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Applying legal precedent, Applicant's selection of the fluid recited in the Markush group would not be patentable. *KSR International Co. v. Teleflex Inc.*; *Ex parte Smith*; *Ex parte Catan*; and *Ex parte Kubin, supra*.

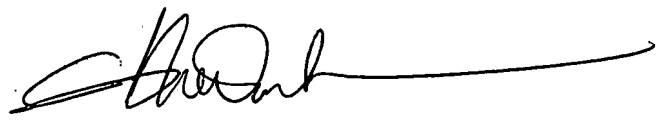
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luong

August 27, 2007



Vinh T. Luong  
Primary Examiner